Appln. No. 10/624,857
Amendment dated February 14, 2008
Reply to Office Action mailed November 14, 2007

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 29 remain in this application. No claims have been cancelled. No claims have been withdrawn or added.

Paragraph 1 of the Office Action

Claims 1 through 29 have been rejected under 35 U.S.C. Section 101 as being directed to non-statutory subject matter.

Claims 1, 9, and 15 have been amended to additional functional structure and relationships.

Withdrawal of the §101 rejection of claims 1 through 29 is therefore respectfully requested.

Paragraph 2 of the Office Action

Claims 1 through 29 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Burstein and DRM (www.reed-electronics.comlsemiconductorlarticleCA231640. (Although it is not entirely clear from the rejection, it appears that the DRM document is the primary reference of the obviousness rejection.)

Claim 1 requires "receiving a diagnostic code generated by a computer system for a component of the computer system", "generating an authentication code for the generated diagnostic code" and "associating the authenticating code with the diagnostic code for the component of the computer system". Claim 9 requires "a diagnostic module on a computer system operable to perform a diagnostic on a component of the computer system and to generate a diagnostic code by the performance of the diagnostic" and "an authentication code generation module on the computer system operable to generate an authentication code associated with the diagnostic code in response to the generation of the diagnostic code by the

Page 6 of 13

diagnostic module". Claim 15 requires "receiving a diagnostic code generated by a computer system for a component of the computer system", generating an authentication code in response to receiving the diagnostic code", and "associating the authentication code with the diagnostic code".

It is conceded in the rejection of the Office Action that the DRM document does not disclose this requirement of the claims, but it is then asserted that:

> Burnstein teaches "generating an authentication code (column 10, line 24 to column 11, line 26, i.e., authentication such as by using start screen and domain manager) associated with the diagnostic code (column 14, line 61 to column 15, line 67; figure 4; claims 15, 16 of Burnstein i.e. diagnostic tools used after authentication permits the use of diagnostic tools)" for the motivation of permitting an agent to register and manage a plurality of domain names for a plurality of different registrants (column 3, lines 5-60) thereby including the use of diagnostics (for management) upon proper authentication (such as would be necessary for an agent).

And it is further asserted that:

> Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to combine the teachings of Burnstein and DRM for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Turning to the referenced portion of the Burstein patent, it is stated at col. 10, line 24 through col. 11, line 26 that (emphasis added):

> Having described the overall structure, this discussion now turns to illustrations of how particularly useful functions are implemented in a preferred aspect of the present invention. Referring to FIG. 2, a start screen generated by the front-end domain manager is illustrated. In this illustrative implementation, it is assumed that <u>the operator accessing the domain manager is acting as an agent</u> for a domain name registrant to modify some information about the domain name or perform another domain management function. <u>Such a start screen preferably requests identification and authentication information *from the operator* to ensure that *the agent is authorized* to use the domain manager and to make changes for that domain.</u> The authentication information is collected by the front-end of the domain manager and passed to the back-end domain server for confirmation. Once logged in or otherwise authenticated through a screen like that illustrated in FIG. 2, a screen such as that illustrated in FIG. 3 appears to prompt for the domain name to be modified or managed by the operator. All communications following the authentication screen are preferably encrypted between the front-end server and the back-end server. The operator enters the

domain name to be active for the initial portion of the session and sends the message to the front-end server. The operator sends the name to the front-end domain manager server, which accesses information about the domain name from the back-end server and returns a function select screen.

Information is gathered about the domain name by the back-end server and passed to the front-end server. The front-end domain manager server sends a screen that allows the operator to select the management functionality to be executed. For example, the front-end domain manager may cause display of a screen like that illustrated in FIG. 4. Most preferably, the returned function screen illustrates all of the functions that can be performed on that domain name by that operator. It should be appreciated that certain functionality is accessible only to the original or authorized registrar for a domain name and so certain registrant agents may be unable to perform certain maintenance or management functions. When the agent initially registered the domain name for the registrant through the domain manager, *the agent is preferably automatically recognized as authoritative* for that domain name. An agent is also preferably recognized as authoritative when the agent has previously accessed the domain manager and received authentication for that particular domain name.

For agents not already recognized as authoritative, further authentication is preferably requested. Operators that are technical contacts or domain name administrators may enter a domain name to be managed and the front-end domain manager issues a screen such as that illustrated in FIG. 5 to request further authentication. As shown in this example, the screen generated by the front-end domain manager might inform the operator not already recognized as authoritative that the operator is asking to be recognized as the authoritative zone and technical contact of the indicated domain name. The screen of FIG. 5 indicates that authorization for the operator's request must be confirmed from the administrative contact for the domain name. The operator clicks on the appropriate button to indicate that the indicated action is desired. The front-end of the domain manager sends a command to the back-end domain manager, which sends an e-mail to the administrative contact for the domain name and waits for confirmation from the administrative contact that authorization is proper. Upon authorization, the back-end domain manager recognizes the operator as the authoritative zone and technical contact for that domain name and sends an appropriate message through the front-end domain manager to the operator.

It is submitted that the Burstein patent does not disclose, either here or elsewhere in the patent, the "generat[ion of] an authentication code [that is] *associated with* the diagnostic code" as required by claim 1. Instead, the Burstein patent discusses the authorization of an "agent", and thus it is the agent that is authorized and not any element or item, such as, for example, any diagnostic code. It is also not evident from the discussion in the Burstein patent that any authentication code is generated, as it is unclear as to how the agent provides "authentication information" to the Burstein system. It is submitted that one of ordinary skill in the art would

Appln. No. 10/624,857
Amendment dated February 14, 2008
Reply to Office Action mailed November 14, 2007

understand that it is the operator/agent that provides the authentication

information, and that the information is not generated.

In connection with this, it should be noted that claim 25 requires that

"a user is incapable of generating the authentication code". The cited

portion of the Burstein patent conflicts with this, particularly at col. 10,

lines 28 through 38, where it states (emphasis added):

> In this illustrative implementation, it is assumed that <u>the operator</u>
> <u>accessing the domain manager is acting as an agent</u> for a domain name
> registrant to modify some information about the domain name or
> perform another domain management function. <u>Such a start screen</u>
> <u>preferably requests identification and authentication information</u> *from*
> *the operator* to ensure that *the agent is authorized* to use the domain
> manager and to make changes for that domain.

Thus, the disclosure of Burstein is in conflict with the requirements of

claim 25. Claim 25 was previously presented but the pending Office Action

did not explain how Burstein teaches this requirement, which is contrary to

the manner in which the operator in Burstein provides the "authentication

information".

Also, claim 26 requires that "the authenticating code is generated

without user intervention". This requirement is also contrary to the cited

statements in the Burstein patent set forth above that the operator supplies

the "authentication information".

Further, claim 27 requires that "the authentication code is generated

by the computer system", which is contrary to Burstein's requirement that

the operator supply the "authentication information".

Still further, claim 24 requires that "the authentication code generated

is unique to the diagnostic code received", which is contrary to the

discussion in Burstein patent that the "authentication information" is

assigned to the operator and the operator uses the same "authentication

information" at each log in.

Page 9 of 13

Appln. No. 10/624,857
Amendment dated February 14, 2008
Reply to Office Action mailed November 14, 2007

Claim 23 requires that "the generating of the authentication code is performed after the receiving of the diagnostic code", and this is in conflict with the discussion in Burstein in which the operator supplies the "authentication information" in order to log in, which appears to be *prior to* any receipt of a diagnostic code.

Claim 28 requires "requesting an authentication code by the computer system after receiving the diagnostic code" and claim 29 requires that "generating the authentication code is performed in response to receiving the diagnostic code", which is different from Burstein for the reasons set forth above with respect to claim 23.

The rejection further cites the Burstein patent at col. 14, line 61 through col. 15, line 67, but nothing there discloses the origin of the authentication information or that the authentication information is associated with a diagnostic code, as opposed to an agent as previously noted, or that any authenticating code is generated in response to the reception of a diagnostic code and is associated with that diagnostic code or is unique to that code.

It is respectfully submitted that, for the purpose of a compact prosecution, if the rejection is maintained, that the specific portions of the Burstein patent that are relied upon as disclosing the origin and timing of the creating of the "authentication information" by the Office be cited, rather than rather large and general portions of the patent that appear to discuss things unrelated to the "authentication information".

With respect to claims 18 through 29, it is stated in the rejection of the Office Action that (emphasis added):

> Regarding claim 17 (authentication code using serial number, etc.), such particular features are well known in the art for the purpose of security and for the purpose of keeping track of data. Regarding claims 18-29, such particular features are well known in the art for the

Page 10 of 13

Appln. No. 10/624,857
Amendment dated February 14, 2008   ·
Reply to Office Action mailed November 14, 2007

<u>purpose of security.</u>

The allegation in the rejection that the "particular features" of claims 18

through 29 "are well-known in the art for the purpose of security" is hereby

challenged under MPEP §2144.03 (B), which states:

> **B. If Official Notice Is Taken of a Fact, Unsupported by**
> **Documentary Evidence, the Technical Line of Reasoning**
> **Underlying a Decision To Take Such Notice Must Be Clear and**
> **Unmistakable**
> ***
> If such notice is taken, the basis for such reasoning must be set forth
> explicitly. The examiner must provide specific factual findings
> predicated on sound technical and scientific reasoning to support his
> or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37
> USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The
> applicant should be presented with the explicit basis on which the
> examiner regards the matter as subject to official notice so as to
> adequately traverse the rejection< in the next reply after the Office
> action in which the common knowledge statement was made.

The contention that the requirements of claims 18 through 29 are "well

known" is generally challenged on the basis that the rejection does not

"provide specific factual findings predicated on sound technical and

scientific reasoning" applied to the requirements of each of these claims,

and the rejection further fails to provide the reasoning why such allegedly

well known features would be obvious modifications of the cited art.

It is further noted that claims 18 through 29 include particular

examples in which the contention of "well-known in the art" is deemed to be

particularly inappropriate. For example, claim 20 requires that the method

further include "receiving a file of valid authentication codes and wherein

generating the authentication code comprises selecting the authentication

code from the file of valid authentication codes." It is submitted that that

is not well known in the art, and that the modification of the hypothetical

combination of DRM and Burstein to include this feature would not be

obvious.

Appln. No. 10/624,857
Amendment dated February 14, 2008
Reply to Office Action mailed November 14, 2007

Further, claim 22 requires that "generating the authentication code comprises receiving the authentication code from a server". Again, it is submitted that this is not well known in art for the purpose of security, and is foreign to the hypothetical combination of DRM and Burstein. Also, claim 23 requires that "the generating of the authentication code is performed after the receiving of the diagnostic code". It is submitted that this requirement of timing is not "well known" for the "purpose[s] of security", and if the assertion of "well known" is maintained, then applicants respectfully request that this be explicitly explained as required by MPEP §2144.03.

Claim 24 requires that "the authentication code generated is unique to the diagnostic code received". This is submitted to distinguish the claimed system from the allegedly obvious combination of DRM and Burstein.

Claim 25 requires that "a user is incapable of generating the authentication code", claim 26 requires that "the authenticating code is generated without user intervention", and claim 27 requires that "the authentication code is generated by the computer system". It is submitted that each of these is not well known, and further distinguish the claimed invention from the allegedly obvious combination.

Further, claim 28 requires "requesting an authentication code by the computer system after receiving the diagnostic code" and claim 29 requires that "generating the authentication code is performed in response to receiving the diagnostic code". It is also submitted that these features have not been established as being well known for the purpose of security, and further explanation is requested, especially since these features distinguish the claimed invention from the DRM-Burstein combination.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Burnstein and the DRM document set forth

Page 12 of 13

Appln. No. 10/624,857
Amendment dated February 14, 2008
Reply to Office Action mailed November 14, 2007

in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 9 and 15. Further, claims 2 through 8 and 23 through 29, which depend from claim 1, claims 10 through 14, which depend from claim 9, and claims 16 through 22, which depend from claim 15 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §103(a) rejection of claims 1 through 29 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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Date: FEB 14, 2008

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Page 13 of 13

PAGE 14/14 * RCVD AT 2/14/2008 5:58:13 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/33 * DNIS:2738300 * CSID:605 339 3357 * DURATION (mm-ss):03-46